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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,363	09/25/2001	Takenori Idehara	011350-287	5946

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EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/961,363

Applicant(s)

IDEHARA ET AL.

Examiner

Ramsey Refai

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-77 is/are pending in the application.
- 4a) Of the above claim(s) 72-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Responsive to Amendment received March 3, 2005.

Claims 1-45 have been canceled. Claims 46-48, 51-55, and 58-63 have been amended.

Claims 66-77 have been added. Claims 46-77 are presented for examination.

### ***Election/Restrictions***

2. Newly submitted claims 72-77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly added claims 72-77 are directed to a method for establishing communication between telephones, which is different from the originally presented invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 72-77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 46-71 are now presented for examination.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 46-47, 49-52, 55-59, 62, and 64-65 rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al (U.S. Patent No. 6,574,664).

6. As per claim 46, Liu et al teach a data transmission device to be used in a system including said data transmission device and a data receiving device which are connected to a network, and at least one portable terminal, said data transmission device (**Figures 2-3 and column 2, lines 15-67**) comprising:

a first transmission unit transmitting to said portable terminal a signal for obtaining device information from said data receiving device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**column 2, lines 52-67 and column 3, lines 33-43; device makes request to the remote discovery node to obtain address of other device**);

a receiving unit receiving the device information from said portable terminal (**column 2, lines 15-67; device obtains address of other devices**); and

a second transmission unit transmitting to said data receiving device a signal for requesting a connection based on the device information (**column 1, lines 33-47 and column 2, lines 23-34; performs management functions on remote devices once address is obtained**).

7. As per claim 47, Liu et al teach the second transmission unit transmits data to said data receiving device via said network after establishing a connection with said data receiving device **(column 1, lines 33-47 and column 2, lines 23-34; performs management functions once connection is established).**

8. As per claim 49, Liu et al teach said connection information contains an identification code for identifying said data receiving device on said network **(column 2, lines 15-34 and abstract; IP/MAC address).**

9. As per claim 50, Liu et al teach said identification code is an IP address **(column 2, lines 15-34 and abstract).**

10. As per claim 51, Liu et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a network, and at least one portable terminal, said data receiving device comprising **(Figures 2-3 and column 2, lines 15-67):**

a transmission unit transmitting device information to said portable terminal according to a request signal from said portable terminal, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device **(column 2, lines 52-67 and column 3, lines 33-43; device makes request to the remote discovery node to obtain address of other device);; and**

a connection unit establishing a connection with said data transmission device according to a signal for requesting the connection transmitted from said data transmission device based on the device information (**column 2, lines 52-67 and column 3, lines 33-43**).

11. As per claim 52, Liu et al teach said transmission unit comprises a communication unit communicating in short distances for transmitting the device information to said portable terminal (**Figures 2-3 and column 33-53**).

12. As per claim 55, Lui et al teach which said communication unit comprises a wired communication unit (**column 1, lines 11-18**).

13. As per claim 56, Liu et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 2, lines 15-34 and abstract; IP/MAC address**).

14. As per claim 57, Liu et al teach said identification code is an IP address (**column 2, lines 15-34 and abstract**).

15. As per claim 58, Liu et al teach a portable terminal to be used in a system including a data transmission device and a data receiving device which are connected to a network, and said portable terminal (**Figures 2-3 and column 2, lines 15-67**), said portable terminal comprising:

a first transmission unit transmitting to said data receiving device a signal for requesting transmission of device information according to a request from said data transmission device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**column 2, lines 52-67 and column 3, lines 33-43; device makes request to the remote discovery node to obtain address of other device**);

a receiving unit receiving the device information from said data receiving device (**column 2, lines 15-67; device obtains address of other devices**); and

a second transmission unit transmitting the device information received from said data receiving device to said data transmission device (**column 1, lines 33-47 and column 2, lines 23-34; performs management functions on remote devices once address is obtained**).

16. As per claim 59, Liu et al teach said first transmission unit and said receiving unit comprise a communication unit communicating in short distances for transmitting and receiving data with said data receiving device (**Figures 2-3 and column 33-53**).

17. As per claim 62, Liu et al teach said communication unit comprises a wired communication unit (**column 1, lines 11-18**).

18. As per claim 64, Liu et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 2, lines 15-34 and abstract; IP/MAC address**).

19. As per claim 65, Liu et al teach said identification code is an IP address (**column 2, lines 15-34 and abstract**).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 48, 53-54, 60-61, 63, and 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al (U.S. Patent No. 6,574,664) in view of Eldridge et al (U.S. Patent No. 6,515,988).

22. As per claim 48, Liu et al fail to teach a mobile telecommunication network. However, Eldridge et al teach data packets are exchange<sup>d</sup> between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.



23. As per claim 53, Liu et al fail to teach said communication comprises a wireless communication unit. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

24. As per claim 54, Liu et al fail to teach said communication unit carries out communication based on either Bluetooth®, IEEE 802.11, HomeRF®, or IrDA®. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

25. As per claim 60, Liu et al fail to teach said communication unit comprises a wireless communication unit. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60**

**and column 45-54).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

26. As per claim 61, Liu et al fail to teach said communication unit carries out communication based on either Bluetooth®, IEEE 802.11, HomeRF®, or IrDA ®. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

27. As per claim 63, Liu et al fail to teach said second transmission unit transmits the device information to said data transmission device via a mobile telecommunication network. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's

invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

28. As per claim 66, Liu et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a network, and a portable terminal, said data receiving device comprising:

a communication unit receiving device information of said data transmission device from said portable terminal, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device **(column 2, lines 52-67 and column 3, lines 33-43; device makes request to the remote discovery node to obtain address of other device); and**

a controller deleting the device information if a certain condition is satisfied **(column 5, lines 57-column 6, lines 5 and column 7, lines 15-19).**

29. Liu et al fails to teach that the communication is wireless. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification **(abstract, Figure 1, column 5, lines 54-60 and column 45-54).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to

obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

30. As per claim 67, Liu et al teach the certain condition includes a condition where the communication unit fails to communicate with the portable terminal device (**column 5, lines 57-column 6, lines 5 and column 7, lines 15-19**).

31. As per claim 68, Liu et al teach the certain condition includes a condition when the portable terminal device is out of a range from the communication unit (**column 5, lines 57-column 6, lines 5 and column 7, lines 15-19**).

32. As per claim 69, Liu et al fail to teach said communication unit carries out communication based on either Bluetooth®, IEEE 802.11, HomeRF®, or IrDA. However, Eldridge et al teach data packets are exchange between a wireless device and fixed machines using IrDA specification (**abstract, Figure 1, column 5, lines 54-60 and column 45-54**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Liu et al and Eldridge et al because Eldridge et al's use of a wireless communication such as IrDA in Liu et al's system would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address.

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33. As per claim 70, Liu et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 2, lines 15-34 and abstract; IP/MAC address**).

34. As per claim 71, Liu et al teach said identification code is an IP address (**column 2, lines 15-34 and abstract**).

### ***Response to Arguments***

35. Applicant's arguments ~~with~~ have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Strobel et al (U.S. Patent No. 6,751,732)
- b. Picoult et al (U.S. Patent No. 6,654,601)
- c. Matsuzaki et al (U.S. Patent No. 6,173,334)
- d. Reed et al (U.S. Patent No. 6,061,739)
- e. Griffith (U.S. Patent No. 6,356,752)
- f. Bi et al (U.S. Patent No. 6,353,599).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

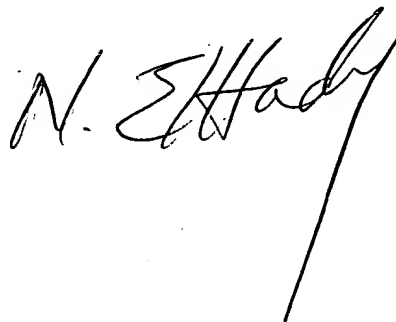
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai  
Examiner  
Art Unit 2154

RR  
April 21, 2005

A handwritten signature in black ink, appearing to read "N. El Hadj", with a long, sweeping vertical stroke extending downwards from the end of the signature.